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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,525	12/05/2003	Peter M. Allred	7678.816.1	8298

7590 11/12/2004

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EXAMINER

O CONNOR, CARY E

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 11/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. ,

10/728,525

Applicant(s)

ALLRED ET AL.

Examiner

Cary E. O'Connor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8-30-04, 6-22-04, 4-8-04
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-26, 28, 30-40, 42, 44-48, 51, 53 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiesel (2002/0081555) in view of Chang et al (2003/0194382). Wiesel shows a treatment composition comprising an adhesive layer 12 comprising a substantially solid adhesive composition (paragraph 0030). The composition also comprises a bleaching gel 16, adjacent to an inner surface of the adhesive layer, comprising at least one dental bleaching agent (30 to 35% hydrogen peroxide), a tackifying agent (carbopol) and a gel carrier. The adhesive disclosed by Wiesel does not have increased adhesiveness to teeth when moistened. Chang shows an article of manufacture for bleaching teeth comprising an adhesive layer that provides substantial adhesive strength when hydrated by water. This type of adhesive does not stick to the hands or face during application, thereby making the composition easier to handle. It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the adhesive of Wiesel with that taught by Chang, because the adhesive of Chang is easier to handle. As to claims 2 and 36, note that

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the composition of Wiesel is in sheet form. As to claims 3, 4, 37 and 38, note that the composition of Wiesel is curved prior to placing the composition over the teeth because it may come in a rolled form (paragraph 0039). As to claim 7, Figures 2 and 3 show the bleaching composition 16 sized and configured so as to approximately terminate near a person's gingival margin. As to claims 8, 9, 44 note paragraph 0041 of Chang. As to claims 10 and 11, note paragraph 0071 of Chang which discloses that the tooth adhesion agent having a concentration of about 20% by weight of the adhesive composition. As to claim 12, Chang does not disclose that the adhesion agent has a concentration in a range of about 40% to about 75% by weight of the adhesive composition. At the time the invention was made, it would have been obvious matter of design choice to a person of ordinary skill in the art to form the adhesive composition having the adhesive agent in the range of 40% to about 75% by weight because applicant has not disclosed that this range of concentration provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with the concentration in the range claimed by applicant. As to claim 13, note that the adhesive composition of Chang may include a humectant (glycerin, see paragraph 0067). As to claims 14-16, neither Wiesel nor Chang disclose the thickness of the adhesive layer. At the time the invention was made, it would have been obvious matter of design choice to a person of ordinary skill in the art to form the adhesive layer with a thickness in the range of .01 to about 3 mm because applicant has not disclosed that this range of thickness provides an advantage, is used for a particular purpose, or

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solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with the thickness in the range claimed by applicant. As to claims 17, 18, 45 and 46 note that Wiesel discloses the addition of therapeutic medicaments or agents for treating sensitive teeth (paragraph 0045). As to claims 20-22, note the concentration of bleaching agent disclosed by Wiesel in paragraph 0034. As to claims 24-26, 28, 35, 39, 40 and 42 note the flexible barrier layer 20 of Wiesel that may be formed of polyolefin or polyurethane (paragraph 0037). As to claims 29 and 30, Wiesel discloses the thickness of the barrier layer as being 30 mil (paragraph 37). At the time the invention was made, it would have been obvious matter of design choice to a person of ordinary skill in the art to form the barrier layer with a thickness in the range of 0.025 mm to about 1.5 mm because applicant has not disclosed that this range of thickness provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with the thickness in the range claimed by applicant. As to claim 31, note that Chang discloses a pouch for storage in paragraph 0062. As to claims 32, 33 and 53, it is well known to provide a plurality of bleaching articles in a kit for use on multiple days. As to claims 34 and 54, note the method of use disclosed by Wiesel in paragraphs 0039 and 0040. As to claim 43, Wiesel discloses that the adhesive layer has a rigidity that partially contributes to structural support of the article (paragraph 0031). As to claim 51, note that the treatment gel of Wiesel covers a portion of the inner surface of the adhesive layer. As to claims

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55-57, note that the adhesive of Wiesel is freeze-dried inherently removing at least a portion of the solvent.

Claims 27, 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiesel (2002/0081555) in view of Chang et al 2003/0194382) as applied to claim 24 above, and further in view of Sagel et al (2002/0018754). Wiesel does not disclose that the polyolefin comprises at least one of polyethylene, high density polyethylene, low density polyethylene, ultra-low density polyethylene, polypropylene, or polytetrafluoroethylene. Sagel shows an article of manufacture comprising a barrier layer made of polyethylene or polytetrafluoroethylene (paragraph 0038). These materials are compatible with the bleaching agents. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use polyethylene or polytetrafluoroethylene as the barrier layer in Wiesel, in view of Sagel, because these materials are compatible with the bleaching agents.

Claims 49, 50 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiesel (2002/0081555) in view of Chang et al 2003/0194382) as applied to claims 39 and 51 above, and further in view of Dirksing et al (6,045, 811). Neither Wiesel or Chang disclose that the adhesive layer comprises a plurality of discontinuous regions or that the gel covers the entire surface of the adhesive layer or are in the form of spaced apart regions. Dirksing shows a treatment strip and discloses that the components each may be a continuous coating or separate stripes or spots (column 4, lines 60+). It would have been obvious to one of ordinary skill in the art to form the treatment strip of Wiesel as modified by Chang with adhesive layer as a plurality of discontinuous regions,

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the gel covering the entire surface of the adhesive layer, or the gel comprising a plurality of spaced-apart regions, in view of Dirksing, depending on the intended use of the device, i.e. if only a portion of the teeth were to be treated.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-47, 53-57 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4, 3, 7, 8, 10-15, 17-32, 36, 35, 37, 38, 40, 41, 44, 45, 47-51 are of copending Application No. 10/784,525. Although the conflicting claims are not identical, they are not patentably distinct from each other because Claims 1 and 35 of the instant application does not include a bleaching agent activator or a bleaching gel as set forth in claims 1 and 32 in the copending application. It has been held that the elimination of an element and its function where not needed is obvious. *In re Karlson*, 136 USPQ 184 (CCPA 1963).

Claims 1-48, 53 and 54 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2,

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9-35, 37-44, 47, 51-55 of copending Application No. 10/692,117. Although the conflicting claims are not identical, they are not patentably distinct from each other because Claims 1 and 35 of the instant application does not include a composition having a tray like configuration or a bleaching gel as set forth in claims 1 and 39 in the copending application. It has been held that the elimination of an element and its function where not needed is obvious. In re Karlson, 136 USPQ 184 (CCPA 1963).

Claims 49, 50-52 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 39 of copending Application No. 10/692,117 in view of Dirksing et al (6,045, 811). The copending claim does not specify that the adhesive layer comprises a plurality of discontinuous regions or that the gel covers the entire surface of the adhesive layer or are in the form of spaced apart regions. Dirksing shows a treatment strip and discloses that the components each may be a continuous coating or separate stripes or spots (column 4, lines 60+). It would have been obvious to one of ordinary skill in the art to form the treatment strip of claim 39 with adhesive layer as a plurality of discontinuous regions, the gel covering the entire surface of the adhesive layer, or the gel comprising a plurality of spaced-apart regions, in view of Dirksing, depending on the intended use of the device, i.e. if only a portion of the teeth were to be treated.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cary E. O'Connor whose telephone number is 571-272-4715. The examiner can normally be reached on M-Th 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on 571-272-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Cary E. O'Connor  
Primary Examiner  
Art Unit 3732

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